

REMARKS/ARGUMENTS

Applicant has studied the Office Action dated June 28, 2005 and has made amendments to the claims. It is submitted that the application, as amended, is in condition for allowance. By virtue of this amendment, claims 1-23 are pending. Claims 1, 3, 9, 11, 12, 14, 21 and 22 are amended. Reconsideration and allowance of the pending claims in view of the above amendments and the following remarks is respectfully requested.

Rejection under 35 U.S.C. §103(a)

In items 1 and 2 of the Office Action, the Examiner rejected claims 1-23 under 35 U.S.C. § 103(a) as being unpatentable over Culliss (U.S. Patent No. 6,539,377) in view of Gormley et al. (U.S. Patent No. 5,628,004).¹ Independent claims 1, 9, 14, 21, and 22 have been amended to distinguish and to more clearly define the present invention. The amendments have not been made to overcome the cited references. Support for the changes is found on pages 9 and 11 of the specification of the instant application. No new matter has been added.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Amended independent claims 1, 14, and 22 recite, *inter alia*:

**receiving a Uniform Resource Locator (URL) string from first
a user;**
determining if the URL string represents a query, if the URL
string represents a query, performing the sub-steps of:
storing the query in a query database;
forwarding the query to a hub processing unit in the
event that the first user selects a query for sharing with a
second user connected to the hub processing unit;
**storing information in an accounting database for
awarding the first user for submitting the query for sharing;**
and
receiving, from a second user, a selection for one of the
stored queries for sharing in the database. (emphasis added)

¹ Applicant makes no statement as to whether such a combination is even proper.

Amended independent claim 9 recites, *inter alia*:

receiving a query selected for sharing by a first user of a client information processing system;
storing the query;
storing information in an accounting database for awarding the first user for submitting the query for sharing;
receiving from a second user a selection of the query shared by the first user;
performing the further sub-steps of:
activating a hyperlink to request a search result set based upon the second user's selection of the hyperlink

Amended independent claim 21 recites, *inter alia*:

means for awarding the first user for selecting the query for sharing

The present invention provides a system and method for sharing web-based search engine queries. A first user creates a search string and stores the string in a database for future use by a second user. Page 11, lines 4-5 of the instant specification. The submission is then recorded and kept in an accounting database for awarding the first user for sharing his search string, thereby ensuring that user receives some recognition for his donation in the form of points or some other award. Page 11, lines 2-8 of the instant specification. Independent claims 1, 9, 14, 21, and 22 have been amended to better clarify this feature.

Neither Culliss nor Gormley et al. teach, mention, or suggest *storing information in an accounting database for awarding the first user for submitting the query for sharing*, as recited in independent claims 1, 14, and 22 of the instant application, *storing information in an accounting database for awarding the first user for submitting the query for sharing*, as recited in independent claim 9 of the instant application, or *means*

for awarding the first user for selecting the query for sharing, as recited in independent claim 21 of the instant application.

Furthermore, as the Examiner correctly states on page 3 of the Office action, Culliss does not explicitly disclose "a selection for one of the stored queries for sharing in the database". The Examiner goes on to combine Gormley et al.¹

Gormley et al., however, is not fully analogous to the present invention. Gormley et al. discloses a computer system for creating and managing a **local database** and is **not at all internet related**, as is the present invention. In fact, nowhere in the Gormley et al. reference do the words "internet," "URL," "HTTP," or "hypertext" appear.

The present invention, in contrast to Gormley et al., is implemented between a web browser and the World Wide Web (i.e., fully web related). See, page 9 of the instant application. Independent claims 1, 14, and 22 have been amended to clarify that the present invention receives URL strings and determines, by looking within the URL string, whether or not the URL string contains a search query.

To further clarify this distinction, Applicant directs the Examiner's attention to FIGs. 11-13 of Gormley et al. and the accompanying text in col. 9, lines 41-57, and col. 10, lines 55-60. A user types query terms directly into fields (shown as boxes) and selects "and"/"or" search options between the boxes. When the execute-query option (block 208) is selected, a computer is programmed to interpret the field selections of the user into what is referred to as a "Structured Query Language" request (block 230) and access to a **database**. It is noted that, Gormley et al. never defines the term "Structured Query Language." Regardless, since the entire focus of Gormley et al. is searching a local database, URL strings are not taught or disclosed.

Therefore, neither Culliss nor Gormley et al. teach or suggest *determining if the URL string represents a query, and if the URL string represents a query, performing the sub-steps of: storing the query ...; forwarding the query ... for sharing ...and receiving ... a*

selection for one of the stored queries ... as recited in amended independent claims 1, 14, and 22 of the instant application.

Continuing on, independent claim 9 recites, *inter alia*:

activating a hyperlink to request a search result set upon user selection of the hyperlink...

Independent claim 21 recites, *inter alia*:

means for activating a hyperlink to request a result set if the shared query is of value to the second user...

As the Examiner correctly states on page 6 of the Office Action, Culliss does not explicitly disclose "*activating a hyperlink to request a search result set upon user selection of the hyperlink.*"

As stated above, Gormley et al. does not disclose any use or connection to the internet. The Gormley et al. reference is void of internet related structures or terms. As a result, Gormley et al. does not show or suggest "*activating a hyperlink to request a search result set upon user selection of the hyperlink*" as recited in claims 9 and 21 of the instant application.

The Applicant hereby submits that in order to combine Culliss with Gormley et al., a motivation would have indeed had to have been present within the references which the Examiner would have had to prove. A purely general remark towards the combination is insufficient in order to justify a rejection under 35 U.S.C. § 103. In order to establish a prima facie case of obviousness by modifying or combining reference teachings, MPEP § 2143 requires that:

- there must be **some suggestion or motivation** to combine the references in the prior art;
- there must be a **reasonable expectation of success** to be found in the prior art;
- and
- the prior art references must teach or suggest **all** the claim limitations.

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It is believed that not one of these three criteria has been met.

Furthermore, 35 U.S.C. § 103 demands that obviousness be tested as of the "the time the invention was made." The Gormley et al. reference has a filing date of November 18, 1994. In 1994, the internet was in a stage of infancy and not well known or heavily relied upon.² Culliss has a later filing date of October 6, 2000. However, and as correctly recognized by the Examiner on pages 3 and 6 of the Office Action, Culliss does not explicitly disclose "a selection for one of the stored queries for sharing in the database" or "capturing search requests for shared queries entered by a second user". In other words, Culliss did not contemplate sharing queries with other users. Therefore, at the time of invention of Culliss, one would have absolutely no motivation to look to Gormley et al. for Gormley's supposed search result sharing features. Gormley et al. would not have been motivated at the time of invention to implement the invention over an internet, because the internet was not well known.

Continuing further, when there is no suggestion or teaching in the prior art for "*determining if the URL string represents a query...and forwarding the query... for sharing*" or for "*activating a hyperlink to request a search result set upon user selection of the hyperlink*" the suggestion can not come from the Applicant's own specification. The Federal Circuit has repeatedly warned against using the Applicant's disclosure as a blueprint to reconstruct the claimed invention out of isolated teachings of the prior art. See MPEP § 2143 and Grain Processing Corp. v. American Maize-Products, 840 F.2d 902, 907, 5 USPQ2d 1788 1792 (Fed. Cir. 1988) and In re Fitch, 972 F.2d 160, 12 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). The prior art reference Culliss taken alone and/or in view of Gormley et al. does not teach, mention, or even suggest "*determining if the URL string represents a query...and forwarding the query... for sharing*" or for "*activating a hyperlink to request a search result set upon user selection of the*

² It wasn't until October 24, 1995 that the Federal Networking Council (FNC) even defined the term "Internet." This definition was developed in consultation with members of the internet and intellectual property rights communities. *The Internet Society* (available at <http://www.isoc.org/internet/history/brief.shtml#fricc>).

hyperlink." Accordingly, claims 1, 9, 14, 21, and 22 distinguish over Culliss taken alone and/or in view of Gormley et al. for this reason as well.

It is accordingly believed to be clear that Culliss, whether taken alone or in any combination with Gormley et al., neither shows nor suggests the features of claims 1, 9, 14, 21, or 22. Claims 1, 9, 14, 21, and 22 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 1, 9, 14, 21, and 22

For the foregoing reasons, independent claims 1, 9, 14, 21, and 22, as amended, distinguish over Culliss taken alone and/or in view of Gormley et al. Claims 1, 9, 14, 21, and 22 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claims 1, 9, 14, 21, and 22, and the Examiner's rejection should be withdrawn.

CONCLUSION

The remaining cited references have been reviewed and are not believed to affect the patentability of the claims as amended.

In this Response, Applicant has amended certain claims. In light of the Office Action, Applicant believes these amendments serve a useful clarification purpose, and are desirable for clarification purposes, independent of patentability. Accordingly, Applicant respectfully submits that the claim amendments do not limit the range of any permissible equivalents.

Applicant acknowledges the continuing duty of candor and good faith to disclosure of information known to be material to the examination of this application. In accordance with 37 CFR §1.56, all such information is dutifully made of record. The foreseeable equivalents of any territory surrendered by amendment are limited to the territory taught by the information of record. No other territory afforded by the doctrine of equivalents is knowingly surrendered and everything else is unforeseeable at the time of this amendment by the Applicant and his attorneys.

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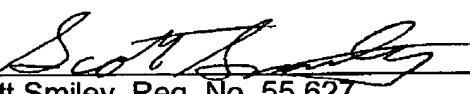
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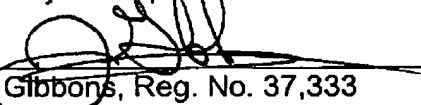
Applicant respectfully submits that all of the grounds for rejection stated in the Examiner's Office Action have been overcome, and that all claims in the application are allowable. No new matter has been added. It is believed that the application is now in condition for allowance, which allowance is respectfully requested.

PLEASE CALL the undersigned if that would expedite the prosecution of this application.

Respectfully submitted,

Date: September 28, 2005

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